

REMARKS

Favorable reconsideration and allowance of the present application is respectfully requested.

Currently, claims 1, 3-35 and 47-64 remain pending in the present application, including independent claims 1, 27, and 47. For example, independent claim 1 is generally directed to mechanically treating broke generated from scrap material accumulated during the production of paper products containing cellulosic fibers and a latex polymer to form fiber aggregates. The latex polymer is present in the broke from about 1% to about 60% by weight. The fiber aggregates have an average size of from about 0.5 to about 6 millimeters. A first portion of said fiber aggregates are coated with said latex polymer, and a second portion of said fiber aggregates remain relatively free from said latex polymer. The mechanical treatment comprises pulping said broke in a pulper.

According to independent claims 1, 27, and 47, the latex polymer is an adhesive latex. This limitation was in previously pending claim 9. As such, Applicants address the rejection of claim 9, instead of claim 1, in these remarks. Previously pending claim 9 was rejected under 35 U.S.C. § 103(a) in view of U.S. Pat. No. 5,277,758 to Brooks, et al. in view of Webster's Dictionary and U.S. Patent No. 3,250,666 to Clark, et al. and in further view of U.S. Pat. No. 6,541,099 to Merker, et al. Brooks, et al. is directed to a method of recovering plastic (polyethylene) from polymeric waste mixed with paper and other contaminants. Col. 1, lines 17-20. The method produces pellets comprising less than about 10 weight percent water and from about 5 weight percent to about 10 weight

percent cellulosic fiber. Col. 4, lines 18-21. Also, the method can produce "spit balls" of cellulosic fiber separated from the plastic material. Col. 7, lines 55-61.

Brooks, et al. discloses that plastic coated waste or plastic waste mixed with paper can be removed from a hydropulper. Col. 1, lines 16-20. The plastic coating waste removed from the hydropulper typically comprises from about 6 to about 33 weight percent paper. This plastic waste is the material subjected to the method disclosed by Brooks, et al. in order to provide the plastic pellets. Col. 2, lines 48-59.

However, as admitted by the Office Action, Brooks, et al. fails to teach that the polymeric waste is anything other than polyethylene. In fact, the Office Action admits that the polyethylene disclosed by Brooks, et al. is not a latex polymer, and cites Webster's Dictionary and Clark, et al. for the notion that a polyethylene latex can be combined with paper fibers.

First of all, Applicants respectfully submit that the plastic waste material discussed in Brooks, et al. is significantly different from the broke treated by the methods of independent claim 1, 27, and 47. According to Brooks, et al., the plastic waste material comprises from about 6 to about 33 weight % paper. Col. 1, lines 41-43. Thus, the plastic is the significant portion of the waste material.

In stark contrast, independent claims 1, 27, and 47 require the latex polymer may comprise from about 1% to about 60% by weight of the broke. Furthermore, the independent claims clarify that "broke" refers to the waste product generated from scrap material accumulated during the production of paper products, such as products that do not fall within the manufacturer's specifications or from excess remaining after completion of the finished product. See, e.g., Paragraph 1. Applicants respectfully

submit that one of ordinary skill in the art would not be motivated to use the process of treating a waste product having relatively small amounts of cellulosic fibers, such as according to Brooks, et al., to treat broke having relatively higher amounts of cellulosic fibers, much less on broke generated from scrap material accumulated during the production of paper products.

Furthermore, Brooks, et al. is directed only to separating a plastic polymer, such as polyethylene, from cellulose fibers. In fact, the Office Action admits that the polyethylene is not a type of adhesive latex, and further cites Merker, et al. as disclosing an adhesive applied to a paper web (e.g., a creping adhesive). The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to use the process disclosed by Brooks, et al. on a paper product having an adhesive latex applied to the fibers instead of polyethylene. However, Applicants respectfully disagree.

No motivation or suggestion exists that the process of Brooks, et al. could be used to separate an adhesive latex from cellulosic fibers. Brooks, et al. provides a process for separating a polyethylene plastic from cellulose fibers. As one of ordinary skill in the art would recognize, the polyethylene plastic is significantly different than the latex adhesive of independent claims 1, 27, and 47. Absolutely no teaching or suggestion exists that the process of Brooks, et al. could be used to separate such an adhesive latex from cellulose fibers. Likewise, Merker, et al. does not provide any teaching or suggestion of any process that can be utilized to separate an adhesive latex from cellulosic fibers. In fact, none of the cited references (either alone or in combination) teach, or even suggest, a method of separating an adhesive latex from

cellulose fibers. Applicants note that in order to establish *prima facie* obviousness, all of the claimed limitations must be taught or suggested in the prior art. See, e.g., MPEP § 2143.03.

Apparently, the Office Action is attempting to state that it would have been obvious to use the process of Brooks, et al. on the paper product disclosed by Merker, et al. However, no motivation exists to make such a combination. Merker, et al. is directed to a paper product that is creped after a bonding material is applied to at least one side of the web. The bonding material contains a creping adhesive, which can be an adhesive latex. However, nowhere does Merker, et al. teach or even suggest that the creping adhesive can be separated from the cellulose fibers of the paper web in any manner. Likewise, no teaching or suggestion exists that the process of Brooks, et al. would, or even could, separate the creping adhesive of Merker, et al. from the cellulose fibers of the paper web. The examiner's rejection is apparently based on an "obvious to try" standard, which is improper under §103. See In re Tomlinson, 150 U.S.P.Q. 623 (C.C.P.A. 1966) ("[A]n element of 'obvious to try' [is present] in any research endeavor . . . and . . . [a] patentability determination based on that as the test would not only be contrary to the statute but would result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name 'research'").

Additionally, Brooks, et al. provides no teaching of a method that provides fiber aggregates coated with a latex polymer, as required by claims 1, 27, and 47. Brooks, et al. discloses that the products of their methods are (1) plastic pellets comprising less than about 10 weight percent water and from about 5 weight percent to about 10 weight

percent cellulosic fiber (Col. 4, lines 17-20) and (2) "spit balls" of cellulosic fiber (Col. 7, lines 59-60). However, Brooks, et al. completely fails to teach that fiber aggregates coated with the latex polymer.¹ Nowhere does Brooks, et al. teach or suggest that their plastic pellets are fiber aggregates of cellulosic fibers coated with latex polymer. In fact, the entire purpose of Brooks, et al. is directed to separating the two types of polymers, not providing a fiber aggregate of cellulosic fiber coated with a latex polymer.

In contrast, independent claims 1, 27, and 47 require that fiber aggregates be formed such that a first portion of the fiber aggregates are coated with the latex polymer and a second portion of the fiber aggregates are relatively free from the latex polymer.

Applicants respectfully submit that Brooks, et al. simply fails to recognize or even address the problems associated with recycling broke containing a latex along with the paper fibers. For example, the latex can be used as a creping adhesive applied to one surface or both surfaces of the paper product. Applicants point out that dependent claim 9 has been amended to require that the latex polymer be an adhesive latex.

Brooks, et al. does not address this type of latex polymer.

Thus, it is believed that the present application is in complete condition for allowance and favorable action, is therefore requested. Examiner Kinney is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this amendment.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

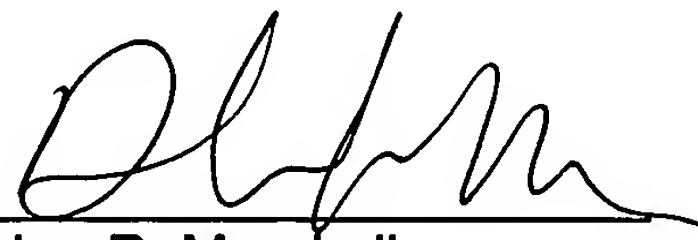
¹ Applicants also note that the Office Action defines "latex polymer" as encompassing polyethylene polymers. Applicants response herein should in no way be construed as an acquiescence to the propriety of this definition.

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Respectfully requested,

DORITY & MANNING, P.A.

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A handwritten signature in black ink, appearing to read 'Alan R. Marshall', written over a horizontal line.

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